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To: USPTO  
Art Unit 3636  
Exr. Winnies. Yip

Date: 03/10/06

From: Werner H. Schroeder  
Patent Agent # 36,387

Number of pages including cover sheet: 6Comments: response to Office Action Rejection

Werner H. Schroeder  
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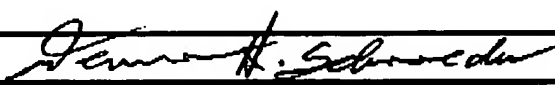
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/813,946	
	Filing Date	07/07/2003	
	First Named Inventor	Kevin T. Connelly	
	Art Unit	3636	
	Examiner Name	Winnie S. Yip	
Total Number of Pages in This Submission	8	Attorney Docket Number	

ENCLOSURES (Check all that apply)		
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Remarks 1) Amended drawing Sheet 2) Amended claims 3) Arguments		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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## **Response to an Office Action Rejection**

**Application No. 10/613,946**

This communication is a response to an Office Action rejection having a mailing date of 02/22/2006 and setting forth a shortened statutory period for response of three months which would expire on 05/22/2006.

In par. 3 of the examiner's office action, the examiner objects to the drawings because the exploded view in Fig. 1 showing separated parts should be combined by a bracket. This will be done in a substitute drawing sheet.

Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kupferman in view of Bilotti and further in view of Johnson. The examiner is using two references to modify what is being claimed and a third reference is being used to further modify THE first modification. The Board of Appeals, the former CCPA and the now CAFC frown on this tactic to reject claims. It is well settled that the proposed modifications by the examiner must flow from the references and not from applicant's specification.

It is pointed out to the examiner that by the time the various modifications have been made to the Kupferman umbrella, the umbrella cannot perform anymore as was intended. This definitely is not an indicia of obviousness as was promulgated in *Graham v. Deere*.

It is pointed out to the examiner that none of the references cited and used in the rejection of the claims is a combination of a shade cover and a rain cover as is explained in the specification. The rain cover is separate from the shade cover but is of the same size. The rain cover is stored in a separate location until the event of rain occurs. At that instant, the rain cover is placed over the shade cover and is fastened to the shade cover at the tips of the ribs.

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Again, this is nowhere taught by the three references.

Claim 1 has been amended to clearly set forth the above noted subject of the invention. Therefore, the amended claim 1 and the claims depending therefrom should be clearly allowable over the cited prior art. None of the references teach a separable water proof rain cover which is not in use and stored separably until the event of rain.

Claims 9 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kupferman in view of Bilotti and Johnson and further in view of Allee.

The examiner is now using four references to reject these claims. The applicant is convinced that one of ordinary skill in the art having these four references in front of her/him would not be able to write the claims 9 - 11. That is requirement under 35 U.S.C. 103.

In view of the fact that claim 1 has been amended to clearly set forth applicant's invention, a rejection of these claims should be moot and overcome.

In view of all of the above, it is believed that all rejections and objections have been answered and have been overcome and the examiner is respectfully requested to allow the presently amended claims and pass the application to an early indication of allowance.



Werner H. Schroeder

Reg. No. 36,387

Date: 03/10/06

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